UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,276	12/03/2003	Brian Jones	60001.283US01	5987

27488 7590 11/16/2007	EXAMINER	
MERCHANT & GOULD (MICROSOFT)	LUDWIG, MATTHEW J	
P.O. BOX 2903		
MINNEAPOLIS, MN 55402-0903	ART UNIT	PAPER NUMBER
	2178	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/727,276	JONES ET AL.
	Examiner	**Art Unit**	
	Matthew J. Ludwig	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 September 2007*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1.   This office is in response to the Request for Continued Examination received 9/13/07.

2.   Claims 1-19 are pending in the application. Claims 1, 9, and 16, are independent claims.

3.   Claims 1-19 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Ayers in

view of AbiWord Schema.

Claim Objections

4.   In reference to independent claim 1, the newly amended claim language states the

following:

> '*wherein the non-structured feature spans the other tags in the ML document*'

It is unclear how the non-structure feature 'spans' other tags. The Examiner believes the

choice of the phrase 'spans the other tags' in regards to a feature of a location of a feature falling

outside other tags, fails to accurately describe the related bookmark example found within the

specification. Furthermore, the claim recites the following phrase:

> '*placing a start feature tag at the start tag location*'

The Examiner believes the start tag location should state the following '*start feature tag

location*' in accordance with the newly formed claim language. Appropriate correction required.

Finally, the last limitation mentions a similar limitation to the one above and therefore the

Examiner asks the applicant to see the explanation above regarding the phrase 'span other tags'.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6.   **Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ayers**

("AbiWord's Potential"), hereafter referred to as "Ayers", in view of AbiWord Schema

(www.abisource.com/awml.xsd), hereafter referred to as "AbiWord Schema".

In reference to independent claim 1, Ayers teaches:

A word processor product that reads a word-processor document stored as a * .abw file

which is written in XML. Ayers also discloses performing an action on the word-processor

document, in the form of creating and examining an AbiWord file that recreates the word

processor's set of features. Ayers describes non structured features and discusses a variety of

non-structured word processing features. See Ayers, page 3. Both a start tag and end tag are

disclosed within the conversion of the word processor document taught by Ayers (compare to

"determining a start feature tag location, determining an end feature tag location wherein

the feature spans the other tags in the ML document"). As presently claimed, it is unclear to

the Examiner how the non-structure feature 'spans' other tags. The Examiner believes the use of

the phrase 'spans the other tags' fails to accurately describe the related bookmark example found

within the specification. The Examiner is interpreting 'spans the other tags' using the AbiWord

document found on page 3 of 4 which describes the tags created for the word processing

document and performing an action on the word-processor document in the form of creating and

examining an AbiWord file that recreates the word processor's set of features. AbiWord schema discloses the location of the published XML Schema at www.w3.org/2000/10/XMLSchema and the XSD for AbiWord, published at www.abisource.com/awml/xsd (See AbiWord Schema, page 1, line 3, and trailer line, bottom of page. The claim language included within the independent claim recites the phrase 'may span other tags while maintaining a well formed ML document'. (compare to "***placing a start tag at the start tag location and an end tag at the end tag location, wherein the start tag and the end tag may span other tags while maintaining a well formed ML document***"). It would have been obvious to one of ordinary skill in the art, having the teachings of Ayers and AbiWord Schema before him at the time the invention was made, to modify the AbiWord documents taught by Ayers to include the AbiWord XSD of AbiWord Schema because it would have given the author a proficient means of validating the AbiWord document and defining tags within a document.

In reference to dependent claim 2, Ayers teaches:

Ayers also discloses performing an action on the word-processor document, in the form of creating and examining an AbiWord file that recreates the word processor's set of features. See Ayers, page 3, paragraph 2. The reference fails to explicitly state the start and end tag including an identifier that may be used to indicate an association between the start tag and the end tag; however, the AbiWord reference discloses an XSD for validating an AbiWord document. (See AbiWord Schema, pages 1-3). The reference provides a means of identifying tags and validating the document utilizing a rich formatting, including styles, lists, sections, and data types (See AbiWord Schema, page 1, lines 16-19.)

In reference to dependent claim 3, Ayers teaches:

Ayers also discloses performing an action on the word-processor document, in the form of creating and examining an AbiWord file that recreates the word processor's set of features. See Ayers, page 3, paragraph 2. The reference fails to explicitly state the start and end tag including an identifier that may be used to indicate an association between the start tag and the end tag; however, the AbiWord reference discloses an XSD for validating an AbiWord document. (See AbiWord Schema, pages 1-3). The reference provides a means of identifying tags and validating the document utilizing a rich formatting, including styles, lists, sections, and data types (See AbiWord Schema, page 1, lines 16-19.)

In reference to dependent claim 4, Ayers teaches:

AbiWord, a word processor product that reads a word-processor document stored as a *.abw file which is written in XML. See Ayers, page 2, 3rd full paragraph.

In reference to dependent claim 5, Ayers teaches:

A word processor product that reads a word-processor document stored as a *.abw file which is written in XML. See Ayers, page 2, third full paragraph. The AbiWord Schema disclose an example of an empty tag on page 2 which is disclosed as a restriction base at the bottom of the page. As presently claimed, the language fails to preclude the Examiner from utilizing the restriction base as an empty tag.

In reference to dependent claim 6 & 7, Ayers teaches:

A word processor product that reads a word-processor document stored as a *.abw file which is written in XML. Ayers also discloses performing an action on the word-processor document, in the form of creating and examining an AbiWord file that recreates the word

processor's set of features. See Ayers, page 3, paragraph 2. Finally, Ayers fails to explicitly state

an XSD or XML Schema definition, which represents a word processor's rich formatting, and is

published and available to other application for interpreting/validating the word-processor

document. See AbiWord Schema, pages 1-3. Both a start tag and end tag are disclosed within the

conversion of the word processor document taught by Ayers (compare to **"determining a start**

tag location, determining an end tag location"). AbiWord schema discloses the location of the

published XML Schema at www.w3.org/2000/10/XMLSchema and the XSD for AbiWord,

published at www.abisource.com/awml/xsd (See AbiWord Schema, page 1, line 3, and trailer

line, bottom of page. The reference provides a means of identifying tags and validating the

document utilizing a rich formatting, including styles, lists, sections, and data types (See

AbiWord Schema, page 1, lines 16-19.)

In reference to dependent claim 8, Ayers teaches:

A word processor product that reads a word-processor document stored as a *.abw file

which is written in XML. Ayers also discloses performing an action on the word-processor

document, in the form of creating and examining an AbiWord file that recreates the word

processor's set of features. See Ayers, page 3, paragraph 2. AbiWord Schema provides

annotations within the XSD file and it would have been obvious to provide these features within

the well-formed structured document because it would have given the author a proficient means

of properly validating various functions found within a word processor document.

In reference to claims 9-15, the claims recite the computer readable medium comprising

instructions for carrying out the document methods as claimed in 1-9. Therefore, the claims are

rejected under similar rationale.

In reference to claims 16-19, the claims recite the system comprising instructions for carrying

out the document features as claimed in 1-9. Therefore, the claims are rejected under similar

rationale.

Response to Arguments

7.   Applicant's arguments filed 5/30/2006 have been fully considered but they are not

persuasive.

The Examiner would like to first point out the objections made to the amended

independent claim. The claim language includes phrases which present matter that is unclear to

the Examiner. Therefore, the Examiner has made an attempt at interpreting the claim based upon

the vague nature of the newly formed independent claim.

The Examiner believes the specification is contradictory to the presently claimed

language found in the independent claim. More specifically, the language found in the claim

states the following:

'wherein the non-structured feature spans the other tags in the ML document'

The language in the specification states the non-structured feature span *arbitrary ranges*

which would be contradictory to the language found within the claims. The language found

within the independent claim state the non-structured feature '*span other tags*'. The use of the

phrase '*span other tags*' is unclear to the Examiner and could be interpreted multiple ways. The

validation techniques taught by the reference suggest creating and examining an AbiWord file

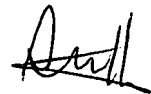that recreates the word processor's set of features. See Ayers, page 3.

Conclusion

8.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Matthew J. Ludwig whose telephone number is 571-272-4127.

The examiner can normally be reached on 9:00am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

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like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ML

STEPHEN HONG
SUPERVISORY PATENT EXAMINER